

REMARKS

Claims 1-19

Claims 1-19 have been rejected under 35 USC 112, second paragraph. Applicants respectfully assert that the claims have been amended in a manner believed to obviate the rejection under 35 USC 112, second paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 1-21

Claims 1-4, 6-13, 18-21 have been rejected under 35 USC 102(a) or 102(e) as being anticipated by Hsiao et al. (US20020030928 A1). Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Hsiao et al. (US20020030928 A1) in view of Fujita et al. (JP2000011323 A).

Applicants respectfully disagree with such rejection. However, in the interest of expediting the prosecution of the current application, Applicants have amended independent claims 1 and 20 to include the subject matter of former dependent claim 5. Because the Examiner has rejected claim 5 under 35 USC 103(a), Applicants believe that such rejection will transfer to claims 1 and 20 upon the incorporation of claim 5.

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 1 and 20 (as amended) prior to the effective 35 USC 102(a) date of Hsiao (March 14, 2002). Per MPEP 715.02, Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 20 based on Hsiao. Further, Applicants respectfully request that the Examiner withdraw the rejection of the remaining claims based their dependence on such claims.

Assuming arguendo that the Examiner wishes to pursue a rejection under 35

USC 103(a)/102(e) based on Hsiao, such a reference would be overcome under the provisions of 35 USC 103(c).

Hsiao was published on March 14, 2002, after the date of invention shown in the attached declaration under 37 CFR 1.131 (November 15, 2001). Therefore, the rejection of claims 1 and 20 under 35 USC 103 would be based on 35 USC 102(e) art. Applicants believe that Hsiao is disqualified as prior art to the present invention under 35 USC 103(c). Please find attached a statement signed by an attorney of record that Hsiao and the present application were both owned by and/or subject to an obligation of assignment to International Business Machines Corporation at the time of invention of the subject matter of the claimed invention in the present application.

Applicants believe that the statement is sufficient to overcome any evidentiary requirement of the Examiner, particularly in light of the following quotes from MPEP 706.02(1)(2)(II):

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

...

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

“Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.”

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

Applicants believe that the disqualification of Hsiao renders claims 1 and 20 allowable over the references cited in the rejection. Additionally, Applicants believe that the remaining claims are further rendered allowable based on their dependence on such claims. Thus, a notice of allowance is respectfully requested.

Should the Examiner wish to discuss this matter further, the Examiner is invited to call the undersigned at (408) 971-2573. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. SJ0920010089US2).

Respectfully submitted,

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